

REMARKS

This Application has been reviewed in light of the February 25, 2010 Final Office Action. At the time of the Final Office Action, Claims 13, 15-20 and 22-26 were pending, and Claims 1-12, 14 and 21 were previously cancelled. Claims 13, 15-20 and 22-26 were rejected in the Final Office Action. Independent Claims 13, 20, and 26 are herein amended. Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. § 112

Claims 13, 15-20 and 22-26 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner alleges:

... there is nothing [in] the specification to disclose "a third party service provided by a third party," "establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service" and "the third party service comprises access to one or more applications."

(Final Office Action, page 4)

Applicants respectfully disagree.

When a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied. (MPEP §2163). This possession may be shown in any number of ways and an Applicant need not describe every claim feature exactly because there is no *in haec verba* requirement. (MPEP § 2163). Rather, to satisfy the written description requirement, all that is required is "reasonable clarity." (MPEP § 2163.02). Also, an adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. (MPEP §§ 2163(I), 2163.02). Finally, it is important to be mindful of the generally inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. (MPEP § 2163(II)(A)(2)) (inventions in "predictable" or "mature" require a lesser showing of possession than inventions in more "unpredictable" arts).

The Examiner acknowledges that paragraph 0015 of the specification discloses "a third item of information about at least one service provided by the local area network"; paragraph 0086 discloses "the WLAN Application Code (WAC) comprises a maximum of three digits (decimal) and uniquely identifies the WLAN application"; and paragraphs 0095-0101 and 0105-0106 disclose the Application codes such as Airport, Hotel, Station or Coffee Shop." (Final Office Action, page 4). However, the Examiner alleges that despite these teachings, "[t]here is nothing to disclose about 'the service and application provided or offered by the third party.'" (Id.)

Applicants respectfully disagree. Applicants submit that one of ordinary skill in the art would reasonably conclude that Applicants' disclosure, including the teachings noted by the Examiner along with other teachings of the specification, adequately described the claim limitations regarding the "third party service."

Applicants' specification discusses situations in which users have access or do not have access to certain applications like "Airport," "Station," "Hotel, Luxury Category," "Hotel, Midrange Category," and "Coffee Shop." Reading this, a person of ordinary skill in the art would have understood two implicit consequences:

1) If access to these applications has to be *granted*, then inherently these are applications from another party than the one claiming access, and

2) As airports, stations, hotels and coffee shops are usually not run by mobile radio providers but rather by other companies, the applications named for these areas are not offered by the mobile radio providers but rather by the companies providing services in these areas.

The specification also teaches:

- "Because of the application of WLAN in hot spots it is assumed that in the future there will be a plurality of public as well as private WLAN providers worldwide, with each also operating their respective networks with different WLAN technologies." (paragraph 0007) (emphasis added)
- "A system and method is disclosed for operating in accordance with the UMTS standard, in at least one mobile radio device wireless local area network..." (paragraph 0011) (emphasis added)

Further, in the Background section, the specification teaches:

“Thus, the connection of WLAN (Wireless Local Area Network) in UMTS is a subject of discussion in, for example, the 3GPP standardization committees. There is great interest in a connection of this kind on account of the technical possibilities of WLAN, for example in order to use in part public, free WLAN access points, referred to as “hot spots”, as an add-on to UMTS in small, local areas with a high subscriber density such as airports, hotels, etc.” (paragraph 0003) (emphasis added)

As a consequence, when read with the teachings of the specification mentioned above:

1) one of ordinary skill in the art would reasonably consider an “access point” as a “service provided by a third party”;

2) based on (a) the phrase “to use *in part*” in paragraph 0003 and/or (b) the fact that according to WLAN a station is associated with one access points out of multiple access points, one of ordinary skill in the art would reasonably conclude that the limitation “establishing and permitting a connection to a local wireless network to receive *at least a portion* of the third party service” is adequately supported; and

3) one of ordinary skill in the art would reasonably consider “free WLAN ... add-on to UMTS” (paragraph 0003) as “at least one application,” thus adequately supporting the limitation “the third party service comprises access to one or more applications.”

In view of the foregoing, Applicants respectfully submit that one of ordinary skill in the art would reasonably conclude that the “third party service” limitations in Applicants’ claims are adequately disclosed in the specification, at least implicitly.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

Amended Claims 13, 20, and 26 are Allowable over the Cited References.

Claims 13 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,941,146 ("*Knauerhase*") in view of U.S. Patent Application Publication No. 2004/0093418 ("*Tuomi*").

Independent Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase* in view of *Tuomi* and U.S. Patent Application Publication No. 2004/0076128 ("*Rao*").

Applicants previously argued:

Finally, Claim 13 explicitly recites that all of the first, second, third and fourth items of network information are all *stored in the same second item of identification information*. Even assuming for the sake of argument that *Knauerhase* teaches first, second, third and fourth items of network information as the Examiner alleges (which Applicants obviously disagree), *Knauerhase* does not teach that these alleged first, second, third and fourth items of network information are *stored in the same item of identification information*.

(Response to Office Action, November 23, 2009)

In response, in the Final Office Action, the Examiner argued that Claim 13 did not actually teach this limitation argued by Applicants. (Final Office Action, page 2: "The claim is silent to what Applicant explicitly argues.") Although Applicants do not necessarily agree, Applicants have amended independent Claims 13, 20, and 26 to explicitly recite this feature. For example, amended Claim 13 now recites, in part:

wherein the first, second, third, and fourth items of network information are stored in the same item of identification information; and

based at least on the first, second, third, and fourth items of network information stored in the same item of identification information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network.

Applicants maintain its position that *Knauerhase* does not teach this feature, which is now explicitly recited in the claims.

In addition, Applicants submit that *Knauerhase* fails to teach “a fourth item of network information uniquely identifying the local area network,” as recited in Claim 13. The Examiner alleges that *Knauerhase* teaches this limitation at “col. 3 lines 27-48; FIG. 5, col. 4 lines 13-21.” (Final Office Action, page 7). However, those portions of *Knauerhase* teach:

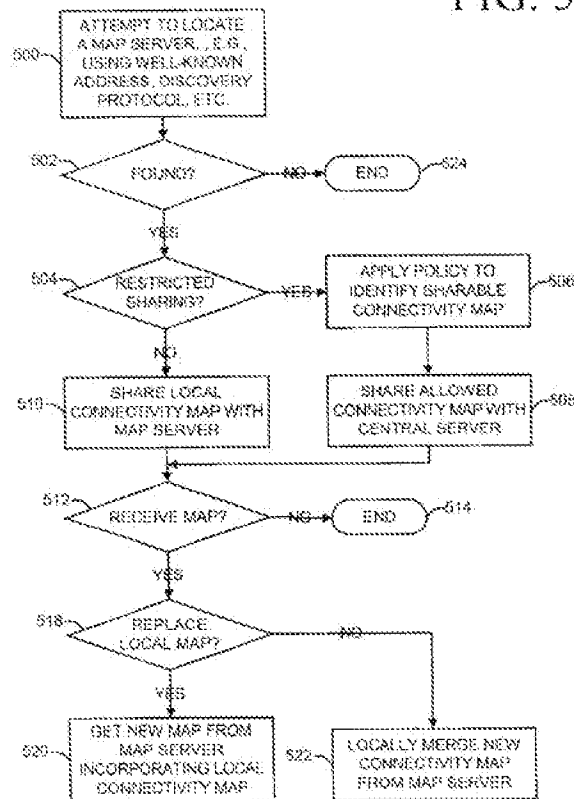
For example, FIG. 3 illustrates a mobile device 300 having, as is becoming frequently more common, multiple wireless (and/or wired) transceivers including a Bluetooth transceiver 302, an 802.11 transceiver 304, and an other transceiver(s) 306 not specifically identified. Assuming FIG. 2 is applied to the device of FIG. 3, the client first selects 206 the Bluetooth transceiver 302 and records 208 whether the identified 200 location provides Bluetooth service. If 210 there are remaining untested transceivers, e.g., the 802.11 and other transceivers 304, 306, they are also tested and their network connectivity recorded 208. When all transceivers have been processed, the illustrated operations end 210. Various embodiments may record 208 various data depending on the needs and requirements. For example, minimally, it is only necessary to record 208 what types of connectivity are available for a particular location.

(col. 3, lines 27-48)

If 502 a map server is found, a test is performed to determine if 504 sharing is restricted. For example, due to security, privacy, or other policy considerations, it might not be desirable for a client to simply dump its entire local connectivity map to the map server, and the client may elect to make available only a portion of its local connectivity map. Thus, if restricted sharing, an appropriate policy or rule is consulted and applied 506, and allowed portions of the client's connectivity map are shared 508.

(col. 3, lines 27-48)

FIG. 5



None of these cited portions of *Knauerhase* teaches an item of network information that *uniquely identifies* a local area network (LAN). First, col. 3, lines 27-48 does not teach any network information that uniquely identifying a LAN. Instead, the passage merely states that the mobile device may be a Bluetooth device, and concludes that “[v]arious embodiments may record 208 various data depending on the needs and requirements. For example, minimally, it is only necessary to record 208 what types of connectivity are available for a particular location.”

Second, col. 3, lines 27-48 and Figure 5 discuss a “connectivity map” and considerations of whether to share the connectivity map with a map server. Applicants do not understand how this can be equated with *an item of network information that uniquely identifies a local area network*. A connectivity map does not inherently uniquely identify a local area network.

Further, even assuming for that sake of argument that one of these passages *did* teach an item of network information that uniquely identifies a local area network (which they do not), *Knauerhase* would still fail to teach that such information is stored in same item of identification information as all of the first, second, and third items of network information recited in Claim 13, and used together to establish and permit a connection to a local wireless network to receive at least a portion of a third party service via the local area network, as recited in Claim 13. *Knauerhase* simply does not teach these recited limitations.

Thus, for at least the reasons set forth above, Applicants respectfully request allowance of amended Claim 13, as well as all claims that depend therefrom. In addition, for analogous reasons, Applicants respectfully request allowance of amended independent Claims 20 and 26, as well as all claims that depend therefrom

All Dependent Claims are Allowable.

Claims 15-16 and 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase* in view of *Tuomi*.

Dependent Claims 17-19 and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase* in view of *Tuomi* and U.S. Patent Application Publication No. 2003/0119481 ("*Haverinen*").

Applicants submit that all dependent claims are allowable at least because they depend from the independent claims shown above to be allowable. Further, *Haverinen* fails to teach the features of the independent claims not taught by *Knauerhase*, *Tuomi*, and *Rao* as discussed above. Further, Applicants do not concede that any of the proposed combinations of references are legally proper. Thus, for at least these reasons, Applicants respectfully request reconsideration and allowance of all pending dependent claims.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

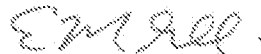
Applicants respectfully submit a Request for Continued Examination (RCE) Transmittal. The Commissioner is authorized to charge the fee of \$810 required to Deposit Account 50-4871 in order to effectuate this filing.

Applicants also authorize the Commissioner to charge \$490 for a two-month extension of time.

Applicants believe there are no fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-457-2030.

Respectfully submitted,
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Date: July 26, 2010

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